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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,826	10/20/2003	Marc Jaker	26503.0800	6229

20322 7590 11/17/2005

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EXAMINER	
PRONE, CHRISTOPHER D	
ART UNIT	**PAPER NUMBER**
3738	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,826	JAKER ET AL.	
	Examiner	Art Unit	
	Christopher D. Prone	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *3-5,8-11 and 14-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6,7,12 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/6/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group 1, Species 1, and Sub-species A, claims 1, 2, 6, 7, 12, and13 in the reply filed on 8/24/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Specification

The disclosure is objected to because of the following informalities: Trademark problems. The use of the trademark "MEMCATH" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Applicant only capitalized the first letter, but should have capitalized the entire word.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims1, 2, 6, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites in line 6-8 that "the medical device is positioned on the membrane sheath inside the tube such that the membrane sheath is interposed between the medical device and the tube." The claim is indefinite because it recites that the medical device is on the sheath and then defines the medical device as being within the sheath. The applicant is advised to reword the claim to further clarify the location of the medical device by replacing the words "on the" with "within".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 5,676,688 Jaker et al.

Jaker discloses the same invention being a delivery assembly comprising a straight tipped tube (12) with first and second open ends, a polytetrafluoroethylene sheath (14) (2:58-65) with first and second ends and a medical drug/device located within (3:12-18 and 11:64-12:5), wherein the first sheath end (32) is disposed within the

tube and the second sheath end (30) is inverted over the tube, a guide assembly (16), and a (42) string attached to the first end of the membrane.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 12, and 13, are rejected under 35 U.S.C. 103 as being unpatentable over United States Patent Application Publication 2001/0044595 Reydel et al. in view of United States Patent 6,280,449 Blake.

Reydel discloses the invention substantially as claimed being a delivery assembly comprising a tube (15) with first and second open ends, a polytetrafluoroethylene sheath (13) [0006] with first and second ends and a medical device located within [0007], wherein the first sheath end (64) is disposed within the tube and the second sheath end (76) is inverted over the tube, a guide assembly (14), and a (48) string attached to the first end of the membrane. Reydel teaches delivery of medical devices for multiple operations, but he does not specifically disclose delivery of an IOL.

Blake teaches the use of a delivery catheter comprising a hollow tube and a sheath for delivery of an Intraocular Ophthalmic Lens in the same field of endeavor for the purpose of providing a replacement lens for a patient.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the delivery device of Reydel with the IOL implant in order to provide a cleaner insertion device, which will cause fewer infections and less irritation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday Through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher D Prone
Examiner
Art Unit 3738

CDP

CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700